

REMARKS

The Final Office Action mailed May 16, 2006, has been received and reviewed. Claims 1 through 67 are currently pending in the application. Claims 12 through 63 are withdrawn from consideration. Claims 1 through 5, 8 and 64 stand rejected. Claims 6, 7, 9 through 11 and 65 through 67 have been objected to as being dependent upon rejected base claims, but the indication of allowable subject matter in such claims is noted with appreciation. Applicants propose to cancel claim 2, amend claim 1, and respectfully request reconsideration of the application as proposed to be amended herein.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent 5,596,282 to Giddings *et al.*

Claims 1 through 5, 8 and 64 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Giddings *et al.*, U.S. Patent 5,596,282 (hereinafter "Giddings"). Applicants respectfully traverse these rejections, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 is directed to a system for marking integrated circuit (IC) packages. As proposed to be amended herein, the system of claim 1 comprises: a plurality of trays, each tray being sized and configured to carry a plurality of discrete integrated circuit (IC) packages; a transport actuator *including a tray transport*; a tray carrier *carried by, and unsecured to, the tray transport of the transport actuator* for receiving at least one tray of IC packages of the plurality of trays; an input shuttle assembly for providing the at least one tray of IC packages to the tray carrier; an output shuttle assembly for receiving the at least one tray of IC packages from the tray carrier; and a laser marking station disposed adjacent a portion of the transport actuator between the input shuttle assembly and the output shuttle assembly.

The Examiner cites Giddings as anticipating independent claim 1 and states “that because the transport actuator (the actuator for moving the belt) moves the tray carrier (the belt, shown as feature 14), it carries and is unsecured to the tray carrier. That is, the transport actuator does not operate by securing or fastening to the tray carrier in order to move it, but rather rolls the tray carrier around it in an unsecured or unfastened manner.” (Office Action, page 4).

Applicants respectfully submit that Giddings fails to describe all of the limitations of claim 1 as proposed to be amended herein.

Giddings discloses a system for testing integrated circuits which includes a first rack (12) that holds trays of integrated circuits (10) and a conveyor (14) that moves trays from the rack along a path through a testing station (16), a rejects/refill station (18) and a laser marking station (20). After marking is completed by the laser marking station, the trays of integrated circuits are placed on another rack (32). (*See, e.g., col. 2, lines 25-45*).

Giddings fails to describe, however, a transport actuator *including a tray transport* and a *tray carrier carried by, and unsecured to, the tray transport of the transport actuator* for receiving at least one tray of IC packages of the plurality of trays.

Even considering the Examiner’s characterization of Giddings, wherein the Examiner considers the belt of the conveyor to be a “tray carrier” and the actuator for moving the conveyor belt be a “transport actuator,” Giddings does not disclose the additional element of a *tray transport* as set forth in claim 1 of the presently claimed invention.

Moreover, other than a general reference to “item 14 and 10” (Final Action, page 2), which are described by Giddings as being the conveyor and the trays, respectively, the Examiner has failed to cite any specific teaching or description by Giddings of a tray transport even though such subject matter was previously set forth in dependent claim 2 (i.e., prior to the proposed amendment herein). Indeed, Applicants note that Giddings provides no description of the conveyor other than to say that it takes trays from the first rack (12) and passes them through various stations to the second rack (32). (*See, e.g., col. 2, lines 25-45*).

Applicants submit that for at least the above reasons claim 1 is clearly allowable over Giddings.

Applicants further submit that claims 3 through 5, 8 and 64 are also allowable as being dependent from an allowable base claim as well as for the additional patentable subject matter introduced thereby.

With respect to claims 3 through 5 and 8, contrary to the Examiner's assertions, Applicants submit that Giddings fails to describe an upper surface of the *tray transport* and a lower surface of the *tray carrier* as including *mutually cooperative physical structures*.

With respect to claims 4, 5 and 8, Applicants submit that Giddings fails to describe the mutually cooperative physical structures as being adapted to *align the tray carrier* on the *tray transport* when the tray carrier is disposed thereon. In addition to Giddings not describing expressly or inherently an additional tray transport element, Giddings does not describe any structures adapted to align such an element with any other structure.

With respect to claims 5 and 8, Applicants submit that Giddings fails to describe portions of the mutually cooperative physical structures as providing a *fulcrum for tilting of the tray carrier with respect to the tray transport*. Assuming *arguendo* that the conveyor belt describes a tray carrier, Giddings does not describe, expressly or inherently, any "tilting" of the conveyor belt, particularly, regarding an undisclosed tray transport. Furthermore, Giddings does not describe, expressly or inherently, a "fulcrum for tilting."

With respect to claim 8, Applicants submit that Giddings fails to describe a *tray transport* that is of lesser longitudinal extent than the *tray carrier*. While the Examiner points to the conveyor (14) as satisfying such a limitation, Giddings fails to expressly or inherently describe such subject matter in association with its conveyor.

With respect to claim 64, Applicants submit that Giddings fails to describe a *tray carrier* that is substantially rectangular and includes a substantially planar upper surface having *upwardly extending stops at each corner thereof*. Assuming *arguendo* that the conveyor belt describes a tray carrier, regardless of viewing orientation, the conveyor belt is not *substantially rectangular*. Additionally, the conveyor belt does not disclose an upper surface having *upwardly extending stops* at a *corner* thereof - or any other location for that matter.

Applicants, therefore, respectfully request reconsideration and allowance of claims 1 through 5, 8 and 64.

Objections to Claims 6, 7, 9 through 11 and 65 through 67/Allowable Subject Matter

Claims 6, 7, 9-11 and 65-67 stand objected to as being dependent upon a rejected base claim, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicants submit that these claims all depend from an allowable base claim and, therefore, are in condition for allowance. Applicants respectfully request reconsideration and allowance of claims 6, 7, 9-11 and 65-67.

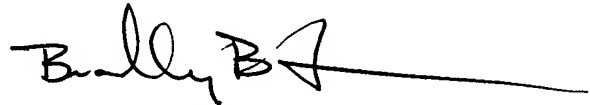
ENTRY OF AMENDMENT

The proposed amendment to claim 1 above should be entered by the Examiner because the amendment is supported by the as-filed specification and drawings and does not add any new matter to the application. Further, the amendment does not raise new issues or require a further search – particularly since such subject matter was considered by the Examiner in examination of claim 2 (prior to its cancellation herein). Finally, if the Examiner determines that the amendment does not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1 through 11 and 64 through 67 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Applicants also note that, upon the allowance of generic claim 1, withdrawn claims pending therefrom should also be allowed. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bradley B. Jensen", followed by a long horizontal line extending to the right.

Bradley B. Jensen
Registration No. 46,801
Attorney for Applicants
TRASKBRITT
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: July 11, 2006
BBJ/aw:slm
Document in ProLaw